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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/503,166	02/14/2000	Joseph A. Yaccarino III	X-9304	6169

7590

08/27/2002

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EXAMINER

PHAN, HIEU

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/503,166

Applicant(s)

YACCARINO III ET AL.

Examiner

Hieu Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 29-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-12 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul et al. (U.S. Patent 6,258,125) in view of Reed (U.S. Patent 5,968,047).

Paul et al. teaches an intervertebral allograft spacer (50, 80) with portions (52, 54) having complimentary and interlocking mating surfaces (56, 58, 82, 84, 86) with plurality of angularly aligned holes (66) and pins (64) as is claimed (Abstract, figures 6-8B and 11, column 2 lines 13-43, column 3 lines 26-59, column 4 lines 27-67 and column 5 lines 1-7). Regarding 1-12 and 29-32, Paul et al. failed to disclose the fastener is threaded, a threaded bolt and nut, knurled rod or a demineralized rod.

Reed teaches different type of demineralized fixation devices such as a screw (80) or rod (90, 100) (Figures 20A and 21A-22, column 2 lines 18-67, column 3 lines 9-26, column 5 lines 28-67 and column 6 lines 1-14). The advantage of using the demineralized fixation devices is the demineralized devices help to prevent an immune system response by the patient. Further, the shape of the device help to better secures an implant.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the teaching of Reed to modify the apparatus Paul et al. to have the fastener is threaded, a threaded bolt and nut, knurled rod or a demineralized rod. The motivations for incorporating the feature of reed into the apparatus of Paul et al. are the

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demineralized devices help to prevent an immune system response by the patient and the shape of the device help to better secure an implant.

Response to Arguments

3. Applicant's arguments filed 07/07/2002 have been fully considered but they are not persuasive. Even though the continuation application of Paul et al. (U.S. Patent 6,258,125) has added Joseph A. Yaccarino, III as an inventor, and United states Patent number 6,025,538, of which the present application is continuation-in-part, added David C. Paul as inventor, does not over come the fact that both patents ('125 and '538) have a different inventive entity and assignee. Due to the fact that the inventive entity and assignee are different, the rejection under 35 U.S.C. 103(a) as being unpatentable over Paul et al. (U.S. Patent 6,258,125) in view of Reed (U.S. Patent 5,968,047) is proper.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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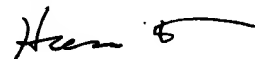
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu Phan whose telephone number is (703) 308-8969. The examiner can normally be reached on Mon.-Fri. from 8:30 a.m. to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax number for this group is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceedings should be directed to the group receptionist whose telephone number is (703) 308-0858.

Hieu Phan



**CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700**